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IN THE

Supreme Court of the United States

October Term, 1977

No. 77-683

MILLER BREWING COMPANY,
Petitioner,

v.

G. HEILEMAN BREWING COMPANY, INC.,
Respondent.

PETITIONER'S REPLY TO BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI

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The critical issue in this case is whether LITE (or "light") is generic (and unprotectable), or descriptive (and therefor protectable), for beer. Respondent's brief, like the decision below, erroneously equates frequently (commonly) used descriptive words with generic names.

The Lanham Act equates "generic" with "common descriptive *name* of an article or substance." 15 U.S.C. §1064.[1] Emphasis added. The Court, Respondent and one *amicus* below, equate "generic" with "common descriptive word" or "term."

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1. 15 U.S.C. §1065 equates "generic" with "common descriptive name of any article or substance." Emphasis added.

Thus, they equate "name of an article or substance" with "word" (or "term"). They are not equals. While the "name of an article or substance" normally is expressed by use of a "word" (or "term"), many, many "words" (and "terms") do not designate the "name of an article or substance." Preceding both "word" (or "term") and "name of an article or substance" with "common descriptive" does nothing to alter this inequality.

Such authorities as *Abercrombie & Fitch Co.* v. *Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976) and *CES Pub. Corp.* v. *St. Regis Publications, Inc.*, 531 F.2d 11 (2d Cir. 1975)[2] equate "generic" words or terms with the "common descriptive name of an article or substance." But no authority known to us equates "generic" with a "common descriptive word" or "term" as did the Court below. To do so produces the curious rule that descriptive words would be eligible for trademark protection only if they were not commonly—that is frequently—used.[3]

That appears to be the rule adopted by the Court below when it held: "A generic or common descriptive term is one which is commonly used as the name *or description* of a kind of goods. It cannot become a trademark under any circumstances." Petition p. A7. Emphasis added. The Court's principal authority for that proposition is *William R. Warner & Co.* v. *Eli Lilly & Co.*, 265 U.S. 526, 528 (1924). In the more than half century since that case was decided, it has come to be recognized that upon acquisition of sec-

2. Quoted at pp. 15-17 of Respondent's Brief in Opposition.

3. When descriptive words acquire trademark status, the right of others to continue to use them descriptively is provided by 15 U.S.C. §1115(b)(4).

ondary meaning, descriptive terms can become trademarks. *Armstrong Paint & Varnish Works* v. *Nu-Enamel Corp.*, 305 U.S. 315, 334-36 (1938); 15 U.S.C. §1052(f).

Having identified the categories it must choose between —"generic or common descriptive term" and "merely descriptive,"[4] the Court stated: "A merely descriptive term specifically *describes a characteristic* or ingredient of an article. It can, by acquiring a secondary meaning, . . . become a valid trademark." Petition p. A7. Emphasis added.

Having thus defined what is "generic" and "merely descriptive" under "General Principles," the Court under the heading "'Light' is Generic" advances as its first sentence of explanation for that conclusion—

> "'Light' has been widely used in the beer industry for many years to *describe* a beer's color, flavor, body, or alcoholic content, or a combination of these or similar *characteristics.*" Petition p. A9. Emphasis added.

Thus, in the space of two pages, the Court says a term is descriptive (rather than generic) if it "describes a characteristic," and that "light" is generic (rather than descriptive) because it "describe[s] characteristics."

4. That too is a mixing of nomenclature. At comon law and by custom, the categories are called "generic" and "descriptive." See *Abercrombie & Fitch, supra;* 1 McCarthy, Trademarks and Unfair Competition §11.1 (1973). The Act calls them "common descriptive name of an article or substance" (15 U.S.C. §§1064, 1065) and "merely descriptive" [15 U.S.C. §1052(f)]. The correct parallel formulation is: "(1) generic or common descriptive name of an article or substance, and (2) descriptive or merely descriptive." The hybrid categories utilized by the Court below are neither consistent nor correct.

Just as revealing is Respondent's independent argument in support of the decision (Brief in Opposition pp. 17-18).

> ". . . Indeed, the very definition of 'generic' advanced by Miller—'a class, kind or group marked *by common characteristics* or by one common characteristic'—supports this conclusion. When the word 'names', 'designates' or 'describes' *a kind, class* or *type* ('genus') of which the product is a 'species' then, as applied to that product, it is 'generic'. [Citations omitted]."

If, as the Court of Appeals stated, "light" has long been used "to describe a beer's color, flavor, body *or* alcoholic content *or* a combination of these *or* similar characteristics" (emphasis added), one must wonder what *common* characteristic or characteristics one applies to "light" beer.[5] Respondent continues—

> ". . . The Court of Appeals did not hold that the word 'light' is generic because it is descriptive, as Miller charges. . . ."

(See the previous three paragraphs.)

> ". . . Rather it held . . . that the word 'light' now describes (and has always described) a *kind, class,* or *type* of beer, to wit, a 'light beer'. . . ."

Quite succinctly, that is what is wrong with the Court of Appeals' decision, and Respondent's position. Upon analysis—and Respondent's analysis here is superb—it is a

5. Petitioner believes that when a full record can be made, the *only* things common to all beers which have been described or characterized as "light" are: (1) they are beer, and (2) for any of a variety of reasons they have been described or characterized as "light." This supports a conclusion that "beer" is generic, but not that "light" is.

totally circular, closed-end syllogism. The characteristic which defines the genus "light beer," they say, is that it is light beer! That is not reasoning; it is merely an unfounded assumption of the conclusion.

For two principal reasons, this error of applicable law is of sufficient importance to justify correction by this Court at this time: *first,* if, as Respondent seems to concede (Brief in Opposition pp. 11-14), the decision can be read by many to control the final outcome of this and nine related cases, then the unprecedented and incorrect notions embodied in the decision threaten to infect the body of trademark law both quickly and pervasively; *second,* the issue of what standards determine what is eligible for trademark protection is a very basic, important and relatively undeveloped one to this area of the law.

Other considerations weighing in favor of review relate to the fundamental fairness of the Court's employing such faulty reasoning to deprive a trademark owner of all right to protect a mark which had functioned for eight years as the brand name solely for its (and its predecessor's) beer, had been registered, and had been built into a major commercial success (at a cost exceeding ten million dollars) before its competitors copied that brand name for their similar products and advanced the post facto rationalization that it was "generic."

Respondent points out (Brief in Opposition p. 6) that we said below that "there is no significant fundamental fact in dispute," which is quite correct. We did not say other facts might not be ultimately elicited, or that there were not "ultimate facts" in dispute. Such a "fact" as

Judge Hand's classic "What do the buyers understand by the word for whose use the parties are contending?"[6] plainly is—and was—in dispute.

Nor does Miller dispute that the "facts" relied upon by the Court of Appeals—dictionary definitions (at least current ones), reference works on chemical terminology, industry publications and magazines and newspapers generally (especially any of the latter, of which there are few or none, which predated other brewers' calling their LITE-like beers LIGHT) are pertinent. Somewhat more persuasive on the subject of "What do the buyers understand" are the partly developed fact that for eight years, until LITE became a success, brewers of low calorie beers made no significant use of "light" in connection with such beers (this can be elaborated at trial) and that a survey showed that more than half the nation's beer drinkers recognized LITE as a brand name.

To dispel any doubt, in view of Respondent's contentions (Brief in Opposition p. 7) as to what Petitioner now argues:

It is Petitioner's position that the Court of Appeals erred in reversing the preliminary injunction in that it (i) relied upon comparatively trivial fundamental facts, (ii) reached an incorrect conclusion of "ultimate fact" that LITE and "light" are generic, and (iii) did so by seriously distorting fundamental and governing precepts of applicable law. We emphasized the third because, presumably, it is of the greatest concern to this Court.

6. Bayer Co. v. United Drug Co., 272 Fed. 505, 509 (S.D.N.Y. 1921).

It is also Petitioner's position that, whatever the final outcome of this case (and others), Petitioner ought not to be divested of its prima facie rights to the trademark LITE without having been afforded an opportunity to test fully, on a fully developed factual record, the contention that LITE is generic.[7]

Conclusion

For the reasons stated, the petition for a writ of certiorari should be granted.

Respectfully submitted,

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7. Respondent is correct that Petitioner does not believe the record "affirmatively establishes the word 'light' is *not* 'generic'". Brief in Opposition p. 7. Affirmatively establishing a negative would be difficult under any circumstances. It is Petitioner's position that the burden on this issue is upon the proponent—Respondent—and that the District Court was quite correct in finding that Respondent had fallen far short of carrying that burden. Petition p. B25.